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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/875,546
Filing Date: June 05, 2001
Appellant(s): KIKINIS, DAN

Brian J. Brisnehan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/3/2009 appealing from the Office action mailed 1/2/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct

(4) Status of Amendments

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Grooters (U.S. Patent No. 6,862,741) published March 1, 2005

Ellis et al. (U.S. Patent No. 6,774,926) published August 10, 2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-7, 9, 12-15, 17, 20-23 and 25-39 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The independent claims state, “**wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG**”.

The examiner notes that although Paragraph 0033 of the instant application states, “***A user of the EPG displayed on computing device 105 may also, through input device 160, display portions of or the entire EPG on video display 105***”, this portion of the specification fails to specifically state that EPG is displayed concurrently on the computing device and the video display. There is no positive recitation that while an EPG is displayed on the computer device 105, the EPG may also be displayed on video display 105 **concurrently**. The specification only teaches that portions of an EPG can be displayed on either device.

Applicant has previously directed the examiner's attention to Paragraph 0008, which states that the EPG may be displayed on a display screen coupled to a computing device and additionally, the user may still display the EPG on the primary display if they so wish, however, Paragraph 0008 makes no such statement regarding the displaying of the EPG on both devices concurrently. The Applicant states, “The ability of the user to still display the EPG on the primary display if they so wish specifies that the EPG on the computing device and on the video display **may be** concurrently displayed”. The examiner notes that the mere teaching of two video displays would not provide the ability for the EPG to **may be** concurrently displayed, however, in order to claim such a feature, the specification must explicitly teach the concurrent display of an EPG on both devices.

Further, new claims 34 and 37 further recite, “**wherein the computing device and the video display are configured such that the portion of the EPG displayed on the computing device is the same as the portion of the EPG concurrently**

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displayed on the video display". As discussed above, the specification fails to support displaying a portion of the EPG on a first display and a portion of the EPG on a second device concurrently, therefore the same portion of the EPG displayed on both devices concurrently cannot be supported.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9, 12, 15, 17, 20, 23 and 25-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Grooters (U.S. Patent No. 6,862,741).

Referring to claim 1, Grooters discloses a video display configured to communication with a receiving system (**see Figure 3 and Column 6, Lines 26-35 for display 226 communicating with information handling system 100**) and to display a video broadcast (**see Column 6, Lines 26-35 for displaying a television program on display 226**).

Grooters also discloses a computing device configured to communication with the receiving system (**see handheld device 228 connected to information handling**

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system 100 in Figure 3), the computing device having a second display configured to concurrently display an Electronic Programming Guide (EPG) corresponding to the video broadcast (**see Figure 3 and Column 6, Lines 13-19**).

Grooters also discloses that the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG (**see Column 7, Lines 24-36 and claim 1 for highlighting a program guide entry on a first display and transmitting and displaying additional program guide information on a second display**).

Referring to claim 9, see the rejection of claim 1.

Referring to claim 17, see the rejection of claims 1.

Referring to claims 25-27, see the rejection of claim 1 for displaying an EPG on both displays (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 28-30, Grooters discloses that the computing device is configured to transmit a signal to the receiving system corresponding to an instruction to display at least a portion of the EPG on the video display concurrently while at least a portion of the EPG is displayed on the second display (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 31-33, see the rejection of claim 1 for display an EPG on both displays (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 34 and 37, Grooters discloses that the computing device and the video display are configured such that the portion of the EPG displayed on the computing device is the same as the portion of the EPG concurrently displayed on the video display (**see again Column 7, Lines 24-35 for teaching displaying time slots for programs (Figure 3) on display 226 and highlighting one of the time slots to display further information on display 228 related to the highlighted time slot on display 226, therefore Grooters clearly teaches displaying two portions that are the same, because the data being displayed on both devices correspond to the same highlighted time slot**).

Referring to claims 35 and 38, Grooters discloses that the computing device and the second display are further configured to display a preview of a broadcast program displayed in the EPG (**see again Column 7, Lines 24-35 for the first and second display devices 226 and 228 displaying time slots and program guide data related to the highlighted time slots, therefore displays 226 and 228 are clearly providing a preview (the time and information related to the highlighted time slot) of broadcast programs (further note Figure 3 for the preview displayed on display 228)**).

Referring to claims 36 and 39, Grooters discloses that the computing device and the video display are configured such that the preview of the broadcast program is displayed on the computing device concurrently while a separate broadcast program is displayed on the video display (**see Figure 3 and Column 6, Lines 13-33 for display 228 displaying previews for broadcast programs while display 226 is displaying an actual broadcast program**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 13-14 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grooters (U.S. Patent No. 6,862,741) in view of Ellis et al. (U.S. Patent No. 6,774,926).

Referring to claims 5-6, Grooters discloses all of the limitations in claim 1, but fail to teach that the computing device is a PDA or web phone.

Ellis discloses that a computing device can be a PDA or web phone (**see Column 6, Lines 23-27 and Lines 66-67 and Column 8, Lines 59-64**).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the computing device, as taught by Grooters, using the PDA or web phone, as taught by Ellis, for the purpose of taking advantage of using devices that the viewer/user already owns to perform the various television control functionality.

Referring to claims 13-14, see the rejection of claims 5-6, respectively.

Referring to claims 21-22, see the rejection of claims 5-6, respectively.

(10) Response to Argument

A. Rejection of claims 1, 5, 6, 9, 13, 14, 17, 21, 22 and 25-39 as failing to comply with the written description requirement

Applicant argues that the claims are supported by the written description by the recitation of original claim 2 and Paragraph 0033 of the instant application. The Examiner respectfully disagrees.

In regards to the original claims, claim 1 recites:

A system comprising:

a video display coupled with a receiving system, the video display to display a video broadcast; and

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a computing device coupled with the receiving system, the computing device having a second display to display an Electronic Programming Guide (EPG) corresponding to the video broadcast, wherein the EPG and the video broadcast are displayed concurrently.

While claim 2 recites:

The system of claim 1, wherein the video display can display a portion of the EPG concurrently displayed on the second display of the computing device.

Therefore, claim 2 teaches that the video display can display **only a portion** of the EPG concurrently displayed on the second display of the computing device.

Currently amended claim 1 recites:

wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG

The currently amended claim 1, now requires displaying **at least a portion of** the EPG on the second display while the video display is concurrently displaying **at least a portion of** the EPG. The difference in scope resides with currently amended claim 1

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now reciting **at least a portion of** in regards to the displays of the video display and the computing device. For example, currently amended claim 1 could be displaying the entire EPG on the computing device, while the video display can be displaying a portion of the EPG. Another example could be that a portion of the EPG is displayed by the computing device, while a completely different portion of the EPG is displayed by the video display. Another example could be that a portion of the EPG is displayed by the computing device, while the same portion of the EPG is displayed by the video display.

However, in regards to all three scenarios discussed above (**supported by the currently amended claim 1**), original claim 2 only provides support for displaying (**by the video display**) only **a portion** of the EPG concurrently displayed on the second display of the computing device.

The Examiner further notes that the same analysis applies to claims 5, 6, 9, 13, 14, 17, 21, 22 and 25-39.

In regards to Paragraph 0033 of the instant application, the paragraph recites "**A user of the EPG displayed on computing device 105 may also, through input device 160, display portions of or the entire EPG on video display 105**". As stated in the previous Office Actions, Paragraph 0033 fails to teach that the EPG and portions of the EPG displayed by the video display and computing device are displayed **concurrently**.

In regards to Page 3, Lines 22-26 of Provisional Application 60/215,681, this

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Paragraph fails to teach concurrent display, as well as portions of the EPG that are being display on the video display and the computing device.

B. Rejection of Claims 1, 9, 17 and 25-39 as anticipated by Grooters

1. Independent Claims 1, 9 and 17

Applicant argues that Grooters fails to teach “**wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG**”, the Examiner respectfully disagrees.

As stated in the previous Office Actions, Column 7, Lines 24-36 teach that while EPG data 214 is displayed on display 226, when the user highlights a particular time slot or channel on the program guide displayed on display 226, a portion of the EPG in the form of information corresponding to the highlighted time slot or channel is displayed on secondary display 228. Note that this is in response to selecting a time slot or channel on the program guide currently being displayed on display 226 and therefore the minimally invasive EPG displayed on display 226 (**the video display displaying at least a portion of the EPG**) and the portion of the EPG in the form of information corresponding to the highlighted time slot or channel (**at least one portion of the EPG displayed on the computing device**) is displayed on secondary display 228, concurrently, thereby providing a higher level of viewability of program content on

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display 226 that would otherwise be compromised if both the minimally invasive EPG and the portion of the EPG in the form of information corresponding to the time slot or channel were displayed on display 226.

2. Claims 25-27

Regarding claims 25-27, see the rejection in the previous Office Action for Grooters teaching these limitations.

3. Claims 28-30

Regarding claims 28-30, see the rejection in the previous Office Action for Grooters teaching these limitations.

4. Claims 31-33

Regarding claims 31-33, see the rejection in the previous Office Action for Grooters teaching these limitations.

5. Claims 34 and 37

Regarding claims 34 and 37, see the rejection in the previous Office Action for

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Grooters teaching these limitations.

6. Claims 35, 36, 38 and 39

Regarding claims 35, 36, 38 and 39, see the rejection in the previous Office Action for Grooters teaching these limitations.

Further Applicant argues that a preview of a broadcast program requires that the preview be an actual video clip. The Examiner disagrees and notes that a preview can be a text preview explaining what the broadcast program is about (**see Column 7, Lines 31-36 for displaying a preview of a broadcast program highlighted on display device 226 in the display screen of display device 228**).

C. Rejection of Claims 5-6, 13-14 and 21-22 over Grooters, in view of Ellis

See the Examiner's rebuttal above regarding Applicant's arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Salce

/Jason P Salce/

Primary Examiner, Art Unit 2421

November 8, 2009

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